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EXAMINER

BROWN, VERNAL U

ART UNIT PAPER NUMBER

2635

DATE MAILED: 07/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/481,512

Applicant(s)

ZONDERVAN, QUINTON YVES

Examiner

Vernal U Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9,12,14 and 21-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,12,14 and 21-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to communication filed on July 10, 2003.

#### ***Response to Amendment***

The examiner has acknowledged the cancellation of claims 1-8, 10-11, 13, 15-20, the amended claims 27, and the addition of claims 46-47.

#### ***Response to Arguments***

Regarding applicant's argument on page 8 concerning modifying a presentation format and sending the electronic message in the modified presentation format, Pepe et al. teaches a method for managing communications of electronic messages between at least two terminal (figure 1) comprising different terminal devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Pepe et al. teaches one terminal device transmitting a message which is presented to another different terminal with a different presentation format selected by the user (col. 5 lines 61-67 and col. 6 lines 1-5).

Regarding applicant's argument on pages 8-9 concerning the delivery format is different from the presentation format, the presentation format is influenced by the delivery format (e.g a message delivered by a pager has a different presentation format than a message delivered by a fax).

Regarding applicant's argument on page 12 concerning claim 14, the applicant's arguments with have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 12, and 46-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9, 12, and 46-47, it is not clear what is receiving the electronic message from the first device.

Referring to claims 46-47, the use of the term “can be” is not a positive recitation of the claimed limitation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 12, 14, 21-46, are rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al. U.S Patent 5742905.

Regarding claim 9, Pepe et al. teaches a method for managing communications of electronic messages between at least two terminal (figure 1) comprising different terminal devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Each of these

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terminal devices has a different message presentation (e.g the fax machine present the message in a text format and the phone presents the message in a voice format). Pepe teaches receiving an electronic message from a first terminal device and modifying the message from the first message presentation format to a modified message presentation format and send the modified message presentation format to the second terminal device by carrying out a media conversion (col. 6 lines 3-5) and (col. 6 lines 11-14).

Regarding claim 12, Pepe et al. teaches that the subscriber provides the network with message routing and delivery instructions and that the instructions are store in a subscriber profile (col. 6 lines 22-24).

Regarding claim 14, Pepe et al. teaches a method for managing communications of electronic messages between at least two terminal (figure 1) comprising different terminal devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Each of these terminal devices has a different message presentation (e.g the fax machine present the message in a text format and the phone presents the message in a voice format). Pepe teaches receiving an electronic message from a first terminal device and modifying the message from the first message presentation format to a modified message presentation format and send the modified message presentation format to the second terminal device by carrying out a media conversion (col. 6 lines 3-5) and (col. 6 lines 11-14). The conversion of the message format is achieved by the network shown in figure 4 and discuss in col. 8 lines 31-53. The network includes a computer that inherently is controlled by computer codes.

Regarding claim 21, Pepe et al. teaches an integrated messaging system (figure 3) comprising different terminal devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Each of these terminal devices inherently transmits and receives messages in different formats. The integrated messaging system further comprises a server system (col. 4 lines 38-40) that receives electronic messages sent from one of the terminal devices and modifies the electronic message to appear as though sent by the other terminal device.

Regarding claims 22-24, Pepe et al. the integrated messaging system (figure 1) shows devices such as a fax machine sending messages to other devices such as a pager. The presentation formats of these devices are different therefore the modified message presentation format is different from the first message presentation format.

Regarding claims 22-24, Pepe et al. the integrated messaging system (figure 1) shows devices such as a fax machine sending messages to other devices such as a pager. The presentation format of these devices is different therefore the modified message presentation format is different from the first message presentation format.

Regarding claims 25 and 38, Pepe et al. teaches the user profile controls the delivery of outgoing messages and the delivery of incoming messages (col. 6 lines 23-27). The message presentation format is therefore specified by the user profile (user of the first terminal).

Regarding claim 26-28, Pepe et al. teaches the transmission of a message from one terminal device to a different terminal device (figure 1). Therefore the presentation format corresponds to a type of terminal other than the first terminal device.

Regarding claim 29 and 39, Pepe et al. teaches the user profile controls the delivery of incoming messages (col. 6 lines 25-27). This is understood to mean that the user receiving a message determines the presentation format of the message.

Regarding claim 30, Pepe et al. teaches a first terminal device is a wireless terminal device (32).

Regarding claim 31, Pepe et al. teaches the wireless device is a pager (34).

Regarding claim 32, Pepe et al. teaches electronic message transmitted to the wireless terminal by performing a summary function on the electronic message (col. 20 lines 13-14). The scripting agent serves the function of translating one message format to another therefore the summary function is inherently performed by the scripting agent.

Regarding claim 33, Pepe et al. teaches that the subscriber provides the network with message routing and delivery instructions and that the instructions are store in a subscriber profile (col. 6 lines 22-24). Pepe et al further teaches the electronic message transmitted to the wireless terminal by performing a summary function on the electronic message (col. 20 lines 13-14). The scripting agent serves the function of translating one message format to another therefore the summary function is inherently performed by the scripting agent.

Regarding claim 34, Pepe et al. teaches a scripting agent (154) that convert text to speech (col. 10 lines 14-16) and a user profile (col. 6 lines 22-24). Pepe et al. further teaches the use of header information to send notification message to the subscriber (col. 27 lines 43-45).

Regarding claim 35, Pepe et al. teaches the user selects the formats used for delivering messages (col. 6 lines 1-3). The presentation format of the received electronic message is therefore allowed to be of the same format as that of the sending device.

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Regarding claim 36, Pepe et al. teaches electronic message transmitted to the wireless terminal by performing a summary function on the electronic message (col. 20 lines 13-14). The scripting agent serves the function of translating one message format to another therefore the summary function is inherently performed by the scripting agent.

Regarding claim 37, a server system operable in an integrated messaging system (figure 5) for facilitating communications between a first terminal device and a second terminal device (figure 1). Pepe et al. teaches the terminal devices include devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Each of these terminal devices inherently transmits and receives messages in different formats. Pepe et al. further teaches modules such as a PDA/PCI interface (col. 4 lines 53-55) that receive an electronic message, modules that modify a format of the electronic message from a first presentation format to a second format (e.g text to fax, col. 8 lines 47-48) as specified by the user profile (col. 8 lines 45-46). Pepe et al. further teaches a module that sends the electronic message in the modified message formation to the second terminal device (col. 10 lines 59-61).

Regarding claim 43, Pepe et al. teaches sending messages between different terminal devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Each of these terminal devices inherently transmits and receives messages in different formats. Pepe et al. further teaches a media conversion to allow, for instance, an email message to be delivered to a fax server (col. 6 lines 3-5). An email delivers to a fax machine (second device) automatically appears as if it originates from a fax machine instead of a computer (first device for sending the email).



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Regarding claim 44, Pepe et al. teaches a first terminal device is a wireless terminal device (32).

Regarding claim 45, Pepe et al. teaches the wireless device is a pager (34).

Regarding claim 46, Pepe et al. teaches a method for managing communications of electronic messages between at least two terminal (figure 1) comprising different terminal devices such as cell phone (32), pager (34), telephone (26), and fax machine (24). Each of these terminal devices has a different message presentation (e.g the fax machine present the message in a text format and the phone presents the message in a voice format). Pepe teaches receiving an electronic message from a first terminal device and modifying the message from the first message presentation format to a modified message presentation format and send the modified message presentation format to the second terminal device by carrying out a media conversion (col. 6 lines 3-5) and (col. 6 lines 11-14). The terminal devices further inherently receive and transmit messages in the same format (e.g a fax machine receive messages in a fax format and transmit messages in a fax format).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al. U.S Patent 5742905 in view of Cleron et al. U.S Patent 6233213.

Regarding claim 47, Pepe et al. teaches a wireless terminal device (32) and also teaches an email presentation format (col. 6 line 4) but is silent on teaching the message presentation is in the HTML format. One skilled in the art recognizes that HTML format is widely use as a presentation format for email messages as evidenced by Cleron et al. (col. 3 lines 25-30).

It would have been obvious to one of ordinary skill in the art to use HTML message presentation format in Pepe et al. as evidenced by Cleron et al. because Pepe et al. suggests an email presentation format and one skilled in the recognizes that HTML format is widely use as a presentation format for email messages as evidenced by Cleron et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vernal U Brown whose telephone number is 703-305-3864. The examiner can normally be reached on M-Th, 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

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Verna Brown

July 24, 2003

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
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